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PATENT
Docket No. 2861-4003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Sylvain CHEMTOB et al.

Group Art Unit: 1647

Serial No.: 09/787,334

Examiner: Robert S. Landsman

Filed: June 19, 2001

For: G PROTEIN-COUPLED RECEPTOR AGONISTS OR ANTAGONISTS

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated August 19, 2002, in which the Examiner subjected pending claims 1-9 to a restriction requirement under 35 USC §121. A response to the Office Action is due on or before September 19, 2002, without an extension of time, therefore, this response is timely filed.

In the Office Action, the Examiner restricted the claims into the following 3 groups: Group I: claims 1-3, 5 and 8 (drawn to a G protein-coupled receptor antagonist, pharmaceutical compositon and a method for preventing premature delivery of a fetus); Group II: claims 1, 2, 4, 5 and 9 (drawn to a G protein-coupled receptor antagonist, pharmaceutical composition and a method for treating and/or preventing dysmenorrhea); and Group III: claims 1, 6 and 7 (drawn to a G protein-coupled receptor antagonist and a method for determining activity of a compound).

In response to the Examiner's restriction requirement, Applicants elect to prosecute the claims of Group I with traverse. Furthermore, as required by the Examiner, in order for the response to the restriction requirement to be complete, Applicants additionally elect the FP receptor sequence of SEQUENCE ID NO: 1, with traverse.

First, Applicants respectfully traverse the restriction requirement to the extent that it separates the claims of Groups I and II into two groups. Claims 1, 2 and 5 are related to peptides. Claims 3 and 8 (premature delivery) and 4 and 9 (dysmenorrhea) are related by the fact that the antagonists of claims 1, 2 and 5 inhibit uterine contractions (as demonstrated in examples IV and I in the application) which are central to both labor and dysmenorrhea. Hence, the inhibition of uterine contractions by the antagonists of this application is the inventive and common feature of medicaments for treating two related conditions, premature labor and dysmemorrhea. Therefore, claims 1, 2, 3, 4, 5, 8 and 9 belong to a single group which should be elected.

Second, Applicants traverse the requirement by the Examiner of the election of only a single species for prosecution on the merits if no generic claim is held allowable. Applicants respectfully submit that searching the specific peptide sequences of SEQ ID NOS: 1-12, (i.e., a total of **twelve** specific peptide sequences), would not be a serious burden on the Examiner. Applicants respectfully point out to the Examiner that as stated in M.P.E.P. §803.04 entitled "Restriction-Nucleotide Sequences", even though nucleotide sequences encoding different proteins are normally considered to constitute independent and distinct inventions, and would be subject to a Restriction Requirement Under 37 CFR §1.141, the Commission had decided to partially waive the requirements of 37 CFR §1.141 *et seq.* and allow, in most cases, a reasonable number of sequences, in most cases, up to ten (10) independent sequences to be claimed in a single application. M.P.E.P. §803.04 also refers to protein amino acid sequences. Therefore, Applicants submit that the twelve SEQUENCE ID NOS of the present claims (which are two more than 10) are a reasonable number of sequences and respectfully submit that SEQUENCE

ID NOS: 2-11 be examined together in this application with the elected FP receptor Sequence ID NO: 1.

Finally, Applicants note that, upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

CONCLUSION

Applicants have elected the claims of Group I, i.e., claims 1-3, 5 and 8, with traverse, for action on the merits, with the election of SEQ ID NO: 1, with traverse, as the species for prosecution on the merits if no generic claim is held allowable. Applicants also respectfully submit that the restriction of the claims of Group I and Group II into two groups be redrawn to include these claims in one group and respectfully request that the Examiner include SEQUENCE ID NOS: 2-12 for prosecution on the merits.

In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: September 19, 2002

By: _____
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